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PTO/SB/21 (09-04)

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## TRANSMITTAL FORM

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Total Number of Pages in This Submission

Application Number 09/706,508

Filing Date November 3, 2000

First Named Inventor Schwartz et al.

Art Unit 2682

Examiner Name Tuan A. Tran

Attorney Docket Number JUR-PT001

### ENCLOSURES (Check all that apply)

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| <input checked="" type="checkbox"/> Fee Attached                          | <input type="checkbox"/> Licensing-related Papers                                       | <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input type="checkbox"/> Amendment/Reply                                  | <input type="checkbox"/> Petition   | <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)        |
| <input type="checkbox"/> After Final                                      | <input type="checkbox"/> Petition to Convert to a Provisional Application               | <input type="checkbox"/> Proprietary Information   |
| <input type="checkbox"/> Affidavits/declaration(s)                        | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input type="checkbox"/> Status Letter   |
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### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	VOLPE AND KOENIG, P.C.		
Signature			
Printed name	Jeffrey M. Glabicki		
Date	11/4/04	Reg. No.	42,584

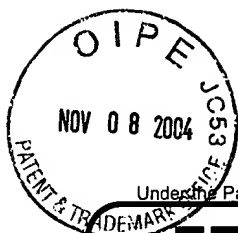
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# FEE TRANSMITTAL for FY 2005

Effective 10/01/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$170.00)

**Complete if Known**

Application Number	09/706,508
Filing Date	November 3, 2000
First Named Inventor	Schwartz et al.
Examiner Name	Tuan A. Tran
Art Unit	2682
Attorney Docket No.	JUR-PT001

**METHOD OF PAYMENT** (check all that apply)☐ Check ☒ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit  
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VOLPE AND KOENIG, P.C.

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☐ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee  
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Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	790	2001	395	Utility filing fee	
1002	350	2002	175	Design filing fee	
1003	550	2003	275	Plant filing fee	
1004	790	2004	395	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$)

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Total Claims		Extra Claims		Fee from below		Fee Paid	
Independent Claim		=		X		=	0.00
Multiple Dependent		=		X		=	0.00

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	88	2201	44	Independent claims in excess of 3
1203	300	2203	150	Multiple dependent claim, if not paid
1204	88	2204	44	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$0.00)

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION** (continued)**3. ADDITIONAL FEES**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	430	2252	215	Extension for reply within second month	
1253	980	2253	490	Extension for reply within third month	
1254	1,530	2254	765	Extension for reply within fourth month	
1255	2,080	2255	1,040	Extension for reply within fifth month	
1401	340	2401	170	Notice of Appeal	
1402	340	2402	170	Filing a brief in support of an appeal	170.00
1403	300	2403	150	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,370	2501	685	Utility issue fee (or reissue)	
1502	490	2502	245	Design issue fee	
1503	660	2503	330	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
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1806	180	1806	180	Submission of Information Disclosure Stmt	
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1810	790	2810	395	For each additional invention to be examined (37 CFR 1.129(b))	
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1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

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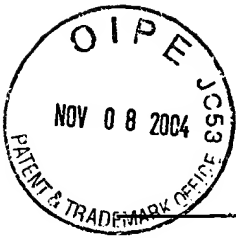
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**PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the **PATENT APPLICATION** of:

Schwartz et al.

**Application No.:** 09/706,508

**Confirmation No.:** 6522

**Filed:** November 3, 2000

For: LOBEMAN

Group: 2682

Examiner: Tuan A. Tran

Our File: JUR-PT001

Date: November 4, 2004

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Alexandria, VA 22313-1450

**APPEAL BRIEF TO THE BOARD OF PATENT APPEALS  
AND INTERFERENCES PURSUANT TO C.F.R. §41.37(c)**

Sir:

Further to the October 29, 2004 Notice of Appeal, the Appellant hereby submits  
this Appeal Brief.

11/09/2004 NROCHA1 00000021 09706508

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**(1) REAL PARTY IN INTEREST**

In this Appeal, the real party in interest is the assignee of record, the Lobeman Group, LLC.

**(2) RELATED APPEALS AND INTERFERENCES**

Appellant and the undersigned representative do not know of any other appeal, interference, or judicial proceeding that is related to, directly affects, is directly affected by, or has a bearing on decision of the Board of Patent Appeals and Interferences (hereinafter the "Board" or the "Board of Appeals") in this Appeal.

**(3) STATUS OF THE CLAIMS**

Claims 1-23, 25-28 and 38-49 are rejected. By a Second Reply Pursuant to 37 C.F.R. §1.116, applicants canceled claims 1-23 and 25-28. Accordingly, Claims 38-49 are the subject of this Appeal and are attached in the Claims Appendix. No other claims are currently pending.

**(4) STATUS OF THE AMENDMENTS**

After the July 30, 2004 Final Rejections, a September 10, 2004 Reply Pursuant to 37 C.F.R. §1.116 was filed. An October 8, 2004 Advisory Action issued indicating that the September 10, 2004 Reply was not entered and was not considered. A Second Reply Pursuant to 37 C.F.R. §1.116 was filed on October 29, 2004 canceling claims 1-23 and 25-28 and providing arguments as to the allowability of remaining claims 38-49.

**(5) SUMMARY OF CLAIMED SUBJECT MATTER**

**Independent Claim 38**

Claim 1 is a communication device. The communication device comprises a speaker (18, Figures 4A, 4B, 4C) and a housing (20, Figures 4A, 4B, 4C). Page 4, lns. 13-15 and 18-20. The speaker (18, Figures 4A, 4B, 4C) is configured to direct sounds towards an ear canal (30, Figures 4A, 4B, 4C) of a listener's ear. Page 4, lns. 15-16. A

component (18, Figures 4A, 4B) is configured to fit substantially in a concha portion (28, Figures 4A, 4B) of the listener's ear. Page 4, lns. 14-15. The housing (20, Figures 4A, 4B, 4C) is connected to the component (18, Figures 4A, 4B, 4C). Page 4, lns. 16-23. The housing (20, Figures 4A, 4B, 4C) is configured to be substantially supported by a pinna (31, Figures 4A, 4B, 4C) of the listener's ear and containing substantially all other components of the communication device other than the speaker. Page 4, lines 18-25.

#### **(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 38 and 40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,230,029 (Hahn et al., referred to hereafter as "Hahn"). Claims 38-39 and 42-44 were rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2214740 (referred to hereafter as "Edmonds") in view of Hahn. Claims 41 and 45-48 were rejected under 35 U.S.C. 103(a) as being unpatentable over Edmonds in view of Hahn and further in view of U.S. Application Publication No. 2002/0094787 (Avnet et al., referred to hereafter as "Avnet").

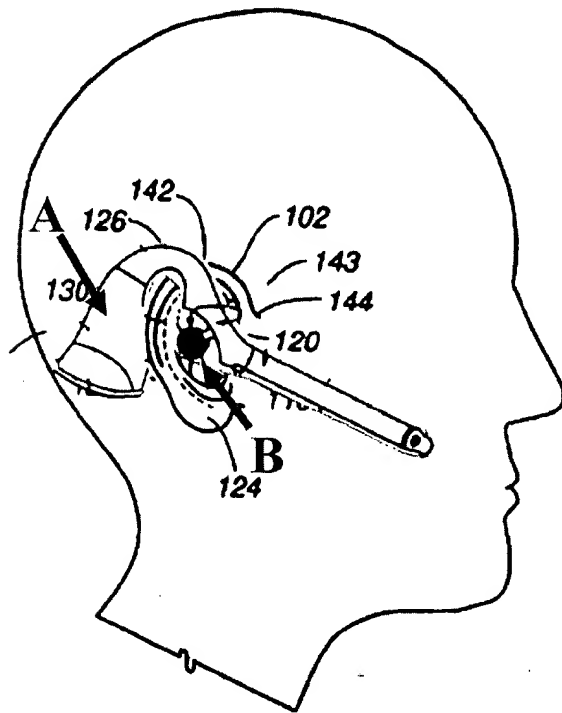
#### **(7) ARGUMENT**

##### **Claims 38-49 Meet the Requirements of 35 U.S.C. 103(a), as being patentable over Hahn, Edmonds and Avnet**

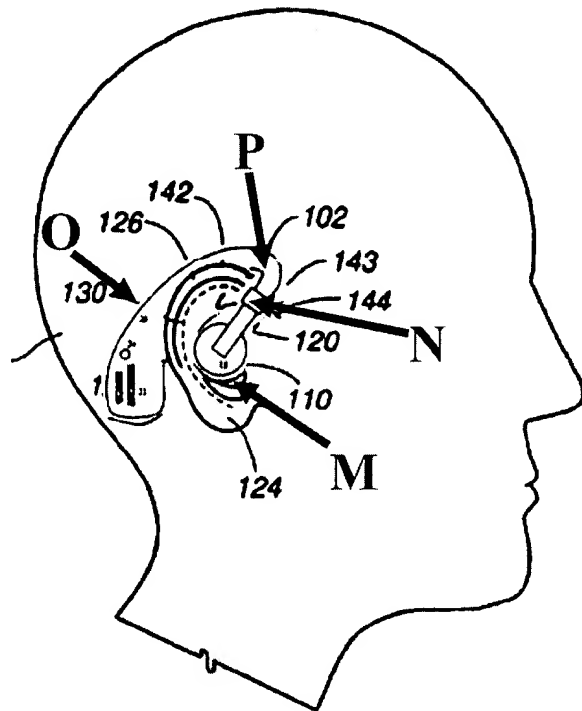
Claim 38 recites both "a component configured to fit in a concha portion of the listener's ear..." and "the housing configured to be substantially supported by a pinna of the listener's ear and containing substantially all other components of the communication device other than the speaker." Hahn does not disclose, teach or suggest either of those recitations.

Although at first glance the embodiment of the invention as illustrated in Figure 3A (present application) may have some similarities to Hahn Figure 3, there are some

distinct and important differences.<sup>1</sup> These distinctions are best illustrated when the two apparatuses are worn, as illustrated as follows (Hahn et al., Figure 3 on the left and Figure 3A of the present application on the right).



**HAHN FIGURE 3  
USED IN ILLUSTRATION**



**FIGURE 3A (09/706,508)  
USED IN ILLUSTRATION**

As illustrated, the Hahn apparatus has a speaker on an arm-like member which pushes against the wearer's ear. The arm extends over the top of the ear and a housing is between the ear and the head (and behind the ear when viewed face-on), which pushes outward on the ear.

The configuration of the Hahn apparatus is described at col. 5, lns. 16-23, as follow: "... the user would deform the ear hook portion 12 [A] towards the speaker module 14 [B] in order to clamp the pinna of the user's ear between the ear hook 12 [A] and the speaker module 14 [B] and thereby fasten the wireless headset module 10 to the user's ear." (Emphasis Added.)

---

<sup>1</sup> Please note that during the August 13, 2004 telephonic interview, the Examiner drew applicants' and applicants' agent's attention to Hahn Figure 3 as disclosing the elements in question.

Hahn also specifically describes the embodiment of Figure 3 similarly at col. 5, lns. 47-52 as follow: "the speaker module [A] can be movable in two or three dimensions as viewed in FIG. 3 to thereby shorten or lengthen the distance between the exterior of the speaker module 14' [A] and the edge of the ear hook 12' [B] in order to clamp the pinna of the user's ear between the speaker module 14' [B] and the ear hook 12' [A]." (Emphasis Added).

This clamping can be illustrated as follows (Hahn et al. on the left and the embodiment of the present application, Figure 3 on the right):

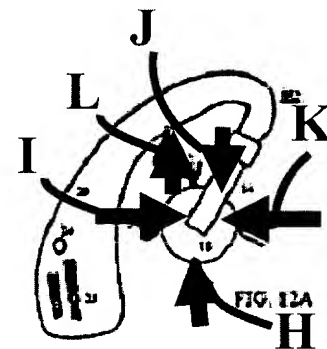
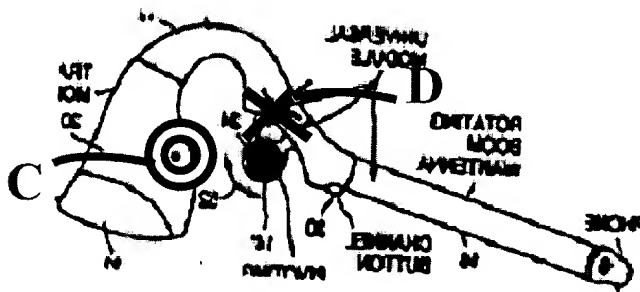
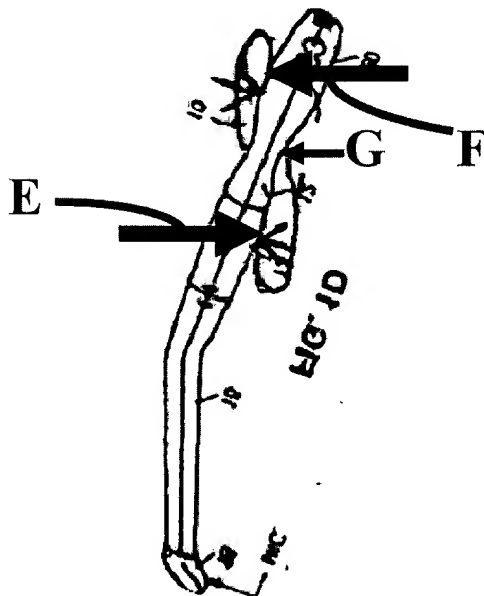


FIGURE 12A (09/706,508)  
ILLUSTRATION





As illustrated by the arrows (E, F) and “X” (D) and circle (C), the Hahn apparatus clamps the user’s ear (G). In the top left illustration, the “X” (D) indicates an into the ear push of the Hahn speaker arm and the circle (C) indicates an outward pull of the housing against the ear, creating the clamping action. The lower left illustration shows the Hahn apparatus clamping the ear (G) by exerting a force from the speaker/arm (arrow E) to the right into the ear (G) and from the housing (arrow F) to the left into the ear (G), essentially clamping the speaker module/arm and housing to the ear. Please also note that in the top view of Hahn that the speaker is not visible, as it is in line with the arm.

The embodiment of Figure 3A of the present application illustrates that the portion of the communication device (illustrated as a circle) extending into the concha is held in place by the concha (M) in all directions (arrows H, I, J and K). The housing is supported as shown by an upward arrow (L) by the pinna. As shown on the right illustration on Page 11, a portion of the communication device fits in the concha (M), when worn. An arm (N) goes to the front portion of the ear (P), when viewed face on, and the housing follows along the ear/head connection. When worn, the pinna of the ear supports the housing from falling, as indicated by the up pointing arrow (L).

Claim 38 recites “a component configured to fit substantially in a concha portion of the listener’s ear.” Webster’s New World Dictionary, Third College Edition © 1988 by Webster’s New World (“Webster”) defines the concha as “the hollow of the external ear”. Clearly, the Hahn apparatus does not have any component fitting into the concha or, in particular, “fit substantially in a concha”. The speaker of Hahn is in line with the arm, which allows the speaker module to clamp the pinna, as described in Hahn. The clamping is essential to hold the Hahn apparatus in place.

Also, claim 38 recites “... the housing configured to be substantially supported by a pinna of the listener’s ear...” Webster’s defines “support” as “to carry or bear the weight of”. As illustrated on page 11, right illustration, the pinna of the ear bears the weight of the housing. With respect to Hahn, the pinna does not bear the weight of the housing. As illustrate above, left illustration, the housing falls behind the ear (from

the perspective of looking into the face of the wearer). Any contact with the pinna is minor. The housing and the speaker module/arm form a clamp on the ear, which keeps the Hahn apparatus in place. Webster's defines "clamp" as "to grip, fasten, or brace with". The Hahn apparatus grips the ear. The device of claim 38 is supported by the ear pinna. None of the other references (Edmonds and Avnet) cure this lack of teaching of the Hahn. Since the remaining claims depend upon claim 38, these claims are also allowable.

**(8) CONCLUSION**

For the reasons stated above, pending claims 38-49 meet the requirements 35 U.S.C. §103(a). Accordingly, the final rejection of the claims under 35 U.S.C. §103(a) should be reversed.

Respectfully submitted,

Schwartz et al.

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**(9) CLAIMS APPENDIX**

(PENDING CLAIMS OF U.S. PATENT APPLICATION NO. 09/706/508)

38. A communication device comprising:

a speaker configured to direct sounds towards an ear canal of a listener's ear and a component configured to fit substantially in a concha portion of the listener's ear; and

a housing connected to the component, the housing configured to be substantially supported by a pinna of the listener's ear and containing substantially all other components of the communication device other than the speaker.

39. The communication device of claim 38 wherein the device is used in promotion of a preexisting publicly available broadcast.

40. The communication device of claim 38 wherein the all other components comprises a variable frequency tuner and a tuned frequency of the tuner is adjustable by a listener.

41. The communication device of claim 38 wherein the all other components comprises a memory storing a recording associated with the predetermined broadcast.

42. The communication device of claim 39 further comprising indicia associated with the preexisting publicly available broadcast.

43. The communication device of claim 39 further comprising indicia associated with an advertiser of the preexisting publicly available broadcast.

44. The communication device of claim 39 further comprising indicia associated with a sponsor of the preexisting publicly available broadcast.

45. The communication device of claim 38 wherein the communication device is a digital recording player and the all other components comprising a memory for storing a digital recording and a digital audio processor for producing an audio signal of the digital recording.

46. The digital recording player of claim 45 wherein the memory is a RAM.

47. The digital recording player of claim 45 wherein the memory is a ROM.

48. The digital recording player of claim 45 further comprising an input for receiving the digital recording.

49. The digital recording player of claim 45 further comprising indicia associated with the digital recording.